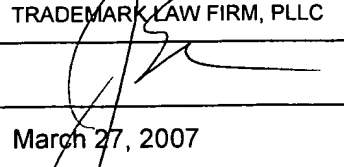


Please type a plus sign (+) inside this box → +

HDP/SB/21 based on PTO/SB/21 (08-00)

2623

<b>TYPE</b> <b>TRANSMITTAL FORM</b> (to be used for correspondence after initial filing) <b>MAR 27 2007</b> <b>PATENT &amp; TRADEMARK OFFICE</b>	Application Number	09/751,159
	Filing Date	December 28, 2000
	Inventor(s)	Marc P. KAPLAN et al.
	Group Art Unit	2623
	Examiner Name	Farzana Hossain
	Attorney Docket Number	129250-002064/US

ENCLOSURES (check all that apply)				
<input type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment  <input type="checkbox"/> After Final (Supplemental)  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Response to Missing Parts/Incomplete Application  <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application)  <input type="checkbox"/> Letter to the Official Draftsperson and _____ Sheets of Formal Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group  <input type="checkbox"/> LETTER SUBMITTING APPEAL BRIEF AND APPEAL BRIEF (w/clean version of pending claims)  <input checked="" type="checkbox"/> Appeal Communication to Group (Notice of Appeal, <u>Brief (Corrected)</u> , Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input type="checkbox"/> Other Enclosure(s) (please identify below):		
<table border="1"><tr><td>Remarks</td><td></td></tr></table>			Remarks	
Remarks				
<b>SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT</b>				
Firm or Individual name	CAPITOL PATENT & TRADEMARK LAW FIRM, PLLC	Attorney Name John E. Curtin		
Signature				
Date	March 27, 2007			
<div style="border: 1px solid black; height: 100px; width: 100%;"></div>				



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 09/751,159

Group Art Unit: 2623

Filing Date: December 28, 2000

Examiner: Farzana Hossain

Applicant: Marc P. Kaplan et. al.

Title: SYSTEM AND METHOD FOR DISTRIBUTING VIDEO  
WITH TARGETED ADVERTISEMENTS USING  
SWITCHED COMMUNICATION NETWORKS

Attorney Docket: 129250-002064/US

---

Customer Service Window

March 27, 2007

Randolph Building

401 Dulany Street

Alexandria, VA 22314

**Mail Stop-APPEAL BRIEF—PATENTS**

**APPELLANTS' BRIEF ON APPEAL (Corrected)**

Sir/Madam:

The following is Applicants'/Appellants' ("Appellants") Corrected brief on appeal in the above-referenced application in response to the Notice mailed February 27, 2007 and Interview Summary mailed March 20, 2007.



**TABLE OF CONTENTS**

	<u>Page</u>
APPELLANTS' BRIEF ON APPEAL .....	1
I. REAL PARTY IN INTEREST .....	1
II. RELATED APPEALS AND INTERFERENCES.....	1
III. STATUS OF CLAIMS .....	1
IV. STATUS OF AMENDMENTS & INTERVIEW RECORD .....	1
V. SUMMARY OF CLAIMED SUBJECT MATTER.....	3
(i) Overview of the Subject Matter of the Independent Claims.....	3
(ii) The Remainder of the Specification Also Supports the Claims.....	4
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	4
VII. ARGUMENTS.....	5
VIII. CLAIMS APPENDIX.....	7
IX. EVIDENCE APPENDIX.....	10
X. RELATED PROCEEDINGS APPENDIX.....	10

Other: Figures 1 and 5



## **APPELLANTS' BRIEF ON APPEAL**

### **I. REAL PARTY IN INTEREST:**

The real party in interest in this appeal is Lucent Technologies Inc. Assignment of the application was submitted to the U.S. Patent and Trademark Office and recorded at Reel 011595, Frame 0131.

### **II. RELATED APPEALS AND INTERFERENCES:**

There are no known appeals or interferences that will affect, be directly affected by, or have a bearing on the Board's decision in this Appeal.

### **III. STATUS OF CLAIMS:**

Claims 1, 7-9, 12, 17 and 18 are pending in the application. Claims 1 and 12 are written in independent form.

Claims 1 and 12 have been finally rejected under 35 U.S.C. §102(e) based on U.S. Patent Application Publication No. 2005/0193410 to Eldering ("Eldering"), and claims 7-9, 17 and 18 have been finally rejected under 35 U.S.C. §103(a) based on a combination of Eldering and U.S. Patent No. 5,544,161 to Bigham et al ("Bigham").

As described in more detail below claims 1, 7-9, 12, 17 and 18 are being appealed.

### **IV. STATUS OF AMENDMENTS & INTERVIEW RECORD:**

An Amendment After Final ("AAF") was filed on September 1, 2006 in response to a Final Office Action mailed July 3<sup>rd</sup>, 2006. In an Advisory Action dated September 19, 2006 ("Advisory") the Examiner stated that the AAF would not be entered because, among other things, it required more than "a cursory review by the Examiner". On October 3<sup>rd</sup>, 2006 the Appellants filed a Notice of Appeal. Without waiving their right to the position taken by the Examiner in the Advisory, the Appellants subsequently submitted a Supplemental AAF on December 4, 2006 which further amended independent claims 1 and 12 to

include features from intervening dependent claims which, based on a fair reading of the Advisory Action, Appellants believed was being requested by the Examiner in order to place the application in proper form for allowance or appeal. The following day, December 5, 2006, the Appellants filed their initial appeal brief. Sometime between the mail date of the Advisory and February 27, 2007 it appears that the Examiner left the employ of the U.S. Patent & Trademark Office. On February 27, 2007 the Appellants received a Notice of Non-Compliant Appeal Brief ("Notice") which stated that the Appellants' initial appeal brief did not contain a correct copy of the appealed claims. On March 15, 2007 the Appellants' attorney, the new Examiner and Primary Examiner Beliveau discussed the Notice via a telephonic interview.

During the interview the Appellants' attorney stated that the Supplemental AAF, which placed dependent claims into the independent claims (and vice-versa), should have been entered because it did not raise any new issues regarding further search and/or consideration. Specific reference was made to claims 5 and 6 as examples of dependent claims being placed into an independent form. Both Examiners disagreed with this position. During the interview it was suggested that the claims could be placed into a proper form for appeal if certain dependent claims were canceled, thus removing the need for any additional search or consideration. Accordingly, claims 2-4, 10, 11, 13, 14 and 19-22 have been canceled in this corrected appeal brief. It is respectfully submitted that these amendments should be entered because the amendments: (a) place the application in condition for allowance; (b) do not raise any new issues regarding further search and/or consideration; (c) do not present any additional claims without canceling the corresponding number of finally rejected claims; and (d) places the application in better form on appeal.

**V. SUMMARY OF CLAIMED SUBJECT MATTER:**

**(i) Overview of the Subject Matter of the Independent Claims**

In general, the present invention is directed at the distribution of video that includes advertisements to targeted subscribers via ATM networks, where the video/advertisements are encapsulated in Internet Protocol ("IP") packets. The subscribers are targeted based on demographic characteristics.

Independent claim 1 reads as follows:

**1. A method of delivering video via an ATM-based switched communication network comprising:**

**transmitting N program streams encapsulated in Internet Protocol (IP) packets from a head end node to one or more egress nodes via the switched network; and**

**inserting N x M advertisements into the N program streams at the one or more egress nodes for delivery to individual subscribers such that a particular subscriber receives a program stream with an advertisement that corresponds to demographic characteristics of that particular subscriber, where N and M are integers and where M represents the number of demographic groupings of the individual subscribers.**

Support for claim 1 can be found, for example, on the following pages of the Specification: page 3, lines 1-29; page 4, lines 22-29; page 5, lines 3-12 and 15-23; page 5, line 25 to page 6, line 11 and page 6, lines 14-20 as well as Figure 1.

Independent claim 12 reads as follows:

**12. In a video distribution network including a head end node, one or more egress nodes, a service management system, and an ATM-based switched communication network, wherein the head end node supplies N program streams encapsulated in Internet Protocol (IP) packets via the switched communication network to the one or more egress nodes, a system for delivering video comprising:**

**at an egress node,**

**a router for receiving the N program streams,**

**a storage element for storing advertisements, and**

**a splicer element for inserting N x M stored advertisements into the N program streams for delivery to individual subscribers, where N**

**and M are integers and where M represents the number of demographic groupings of the individual subscribers,**

**wherein a particular subscriber receives a program stream with an advertisement that corresponds to demographic characteristics of that particular subscriber.**

Support for claim 12 can be found, for example, on similar pages of the Specification as claim 1 as well as on: page 9, line 27 to page 12, line 10 and page 12, line 24 to page 14, line 13 as well as Figure 5.

In order to make the overview set forth above concise, and thus useful to the members of the Board, the Appellants note that only some of the disclosure from the Specification that supports the independent claims has been included in the overview. Thus, the disclosure that has been included, or referred to, above only represents a portion of the total disclosure set forth in the Specification that supports the independent claims.

**(ii) The Remainder of the Specification Also Supports the Claims**

The Appellants note that there is additional disclosure that also supports the independent and dependent claims. Further, by presenting the disclosure above the Appellants do not represent that this is the only evidence that supports the independent claims nor do Appellants necessarily represent that this disclosure can be used to fully interpret the claims of the present invention. Instead, this disclosure is an overview of the claimed subject matter.

**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL:**

Appellants seek the Board's review and reversal of the Examiner's rejection of claims 1 and 12 under 35 U.S.C. §102(e) based on Eldering, and claims 7-9, 17 and 18 under 35 U.S.C. §103(a) based on a combination of Eldering and Bigham.

## **VII. ARGUMENTS:**

### **A. The Section 102 Rejections of Claims 1 and 12**

Claims 1 and 12 were rejected under 35 U.S.C. §102(e) as being unpatentable over Eldering. Appellants respectfully disagree for at least the following reasons.

Claims 1 and 12 include the feature of transmitting/supplying one or more program streams (“transmissions”) encapsulated in Internet Protocol (IP) packets from a head end node to one or more egress nodes via an ATM switched network. Eldering does not disclose such transmissions.

As the Examiner admits in the Final Office Action (page 10), Eldering does not disclose the claimed transmissions over an ATM network.

Because Eldering does not disclose each of the features of claims 1 and 12 it cannot anticipate these claims under 35 U.S.C. §102(e). Accordingly, Appellants respectfully request that the members of the Board reverse the decision of the Examiner and allow claims 1 and 12.

### **B. The Section 103 Rejection of Claims 7-9, 17 and 18**

Claims 7-9, 17 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Eldering in view of Bigham. Appellants respectfully disagree for at least the following reasons.

Because each of the rejected claims depends on either claim 1 or 12 they are patentable over the combination of Eldering and Bigham for the reasons set forth above with respect to claims 1 and 12 and because Bigham does not overcome the deficiencies of Eldering.

In more detail, though Bigham discloses an ATM network, it does not disclose or suggest the transmission of one or more program streams encapsulated in IP packets *from* a head end node to one or more egress nodes via an ATM-based switched network, as in claims 7-9, 17 and 18. Rather,



Bigham's transmissions appear to be over an ATM network to a head-end (e.g., broadcast consolidation section 100, see column 10, lines 54-55).

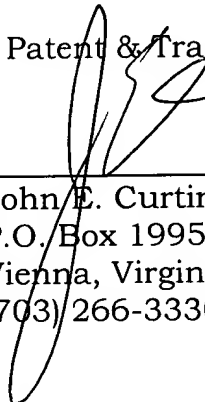
In sum, Appellants respectfully submit that the subject matter of claims 7-9, 17 and 18 would not have been obvious to one of ordinary skill in the art at the time the present application was filed from a reading of the disclosures of Eldering and Bigham.

Appellants respectfully request that the members of the Board reverse the decision of the Examiner and allow claims 7-9, 17 and 18.

Respectfully submitted,

Capitol Patent & Trademark Law Firm, PLLC

By:



\_\_\_\_\_  
John E. Curtin, Reg. No. 37,602  
P.O. Box 1995  
Vienna, Virginia 22183  
(703) 266-3330

## **VIII. CLAIMS APPENDIX**

### **LISTING OF CLAIMS**

1. A method of delivering video via an ATM-based switched communication network comprising:

transmitting N program streams encapsulated in Internet Protocol (IP) packets from a head end node to one or more egress nodes via the switched network; and

inserting N x M advertisements into the N program streams at the one or more egress nodes for delivery to individual subscribers such that a particular subscriber receives a program stream with an advertisement that corresponds to demographic characteristics of that particular subscriber, where N and M are integers and where M represents the number of demographic groupings of the individual subscribers.

2. (Canceled).

3. (Canceled).

4. (Canceled).

5. (Cancelled).

6. (Cancelled).

7. The method according to claim 1, wherein the step of transmitting comprises multicasting the program streams via the switched communication network.

8. The method according to claim 7, further comprising the step of transmitting the ad-inserted streams to subscribers via a digital subscriber line (DSL) interface.

9. (Original) The method according to claim 7, further comprising the step of transmitting the ad-inserted streams to subscribers via an Ethernet interface.

10. (Canceled).

11. (Canceled).

12. In a video distribution network including a head end node, one or more egress nodes, a service management system, and an ATM-based switched communication network, wherein the head end node supplies N program streams encapsulated in Internet Protocol (IP) packets via the switched communication network to the one or more egress nodes, a system for delivering video comprising:

at an egress node,

a router for receiving the N program streams,

a storage element for storing advertisements, and

a splicer element for inserting  $N \times M$  stored advertisements into the  $N$  program streams for delivery to individual subscribers, where  $N$  and  $M$  are integers and where  $M$  represents the number of demographic groupings of the individual subscribers,

wherein a particular subscriber receives a program stream with an advertisement that corresponds to demographic characteristics of that particular subscriber.

13. (Canceled).

14. (Canceled).

15. (Cancelled).

16. (Cancelled).

17. The system according to claim 12, wherein the program streams are distributed via multicasting in the switched communication network.

18. The system according to claim 17, wherein the ad-inserted streams are distributed to subscribers via an interface selected from the group consisting of a digital subscriber line (DSL) interface and an Ethernet interface.

19. (Canceled).

20. (Canceled).

21. (Canceled).

22. (Canceled).

**IX. EVIDENCE APPENDIX**

None.

**X. RELATED PROCEEDINGS APPENDIX**

None.



FIG. 1

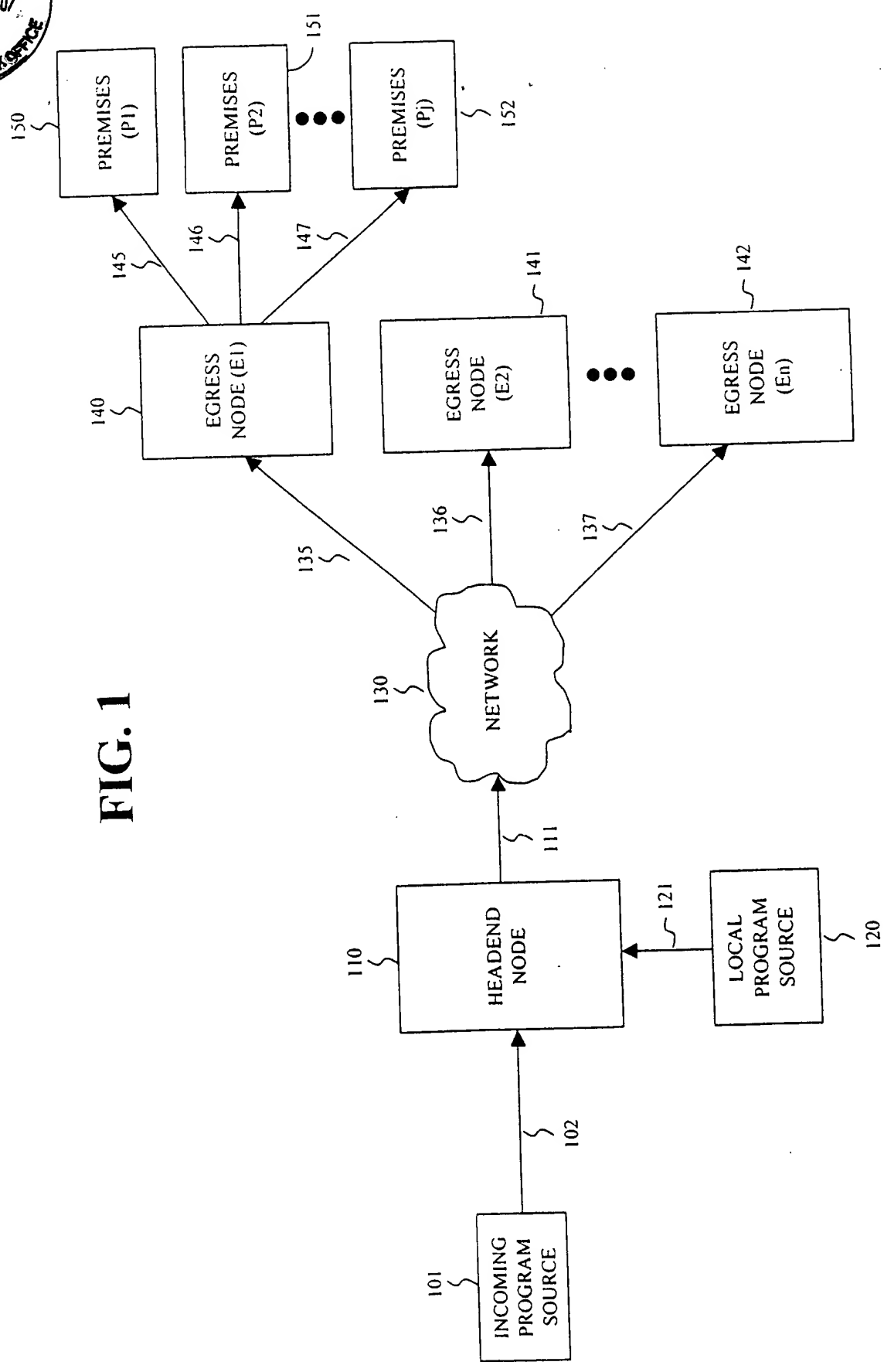


FIG. 5

